

## **REMARKS/ARGUMENT**

Applicant – through the assignee of this technology/application – has given careful consideration to the grounds of the examiner in rejecting a handful of claims under 35 USC §102(b) using a new reference, Clement U.S. Pat. 5,403,268, not cited by the examiner earlier. Each amendment made herein has been made for purposes of clarification of the subject matter sought to be patented, as originally filed in the PCT International application and for which national U.S. entry was made. All amendments enjoy full support of the specification, claims, drawings, and abstract as filed. No new matter is included. Each claim recites distinguishable features. Please cancel claims 15 – 19 drawn to an unelected invention. Circumstances warrant all amendments made herein be entered; therefore, applicant respectfully solicits reconsideration.

Under 37 CFR 1.116 (b) provides for amendments made after a final rejection in an application, but before or on the same date of filing an appeal, as follows: “(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action; . . . or (3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.”

In the event the examiner considers any of the amendments made, herein, to “touch[ing] the merits of the application,” applicant submits that good and sufficient reasons do exist for entering the instant full amendment. Included among the many reasons: Not giving applicant an opportunity to respond to the claim rejections to claims 1, 10, 12, 13, and 21 using Clement – a reference not cited earlier by the examiner nor earlier seen by applicant – would introduce a substantial element of unfairness to the instant proceedings, and to enter amendments made herein to the claims the examiner has allowed (claims 2-3, 5-9, 11, 14, 20, 22-28 stand *objected to* for being dependent upon a rejected base claim) without consideration of the amendments to claims 1, 10, 12, 13, and 21, would lead to very inefficient prosecution with exorbitant fees.

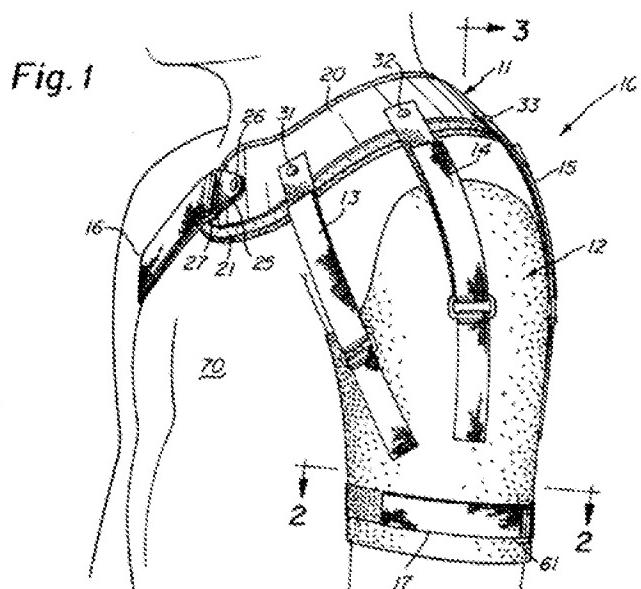
### **Rejection under 35 USC §102(b) using Clement Pat. N° 5,403,268 ('Clement')**

Claims 1, 10, 12, 13, and 21 stand rejected under §102(b) as being anticipated by Clement. Clement describes its stiff two-piece shoulder saddle 11 made up of a stiff yet flexible metal piece 20 formed into a thin band or strip (col. Lines 54 – 57) and a cloth, textile tape or polymeric strap or band 16 (col. 3, lines 1–6) attached by way of rivet 24 and mounting tab 25:

The shoulder saddle extends from the chest of an individual over the shoulder to the back thereof providing for positive support. It is held in place by a strap or band 16 best shown in FIG. 4, attached to one end of the saddle by rivet 24. The other end of the saddle 11 carries a mounting tab 25 riveted at 26 to the saddle. . . .

Applicant's therapeutic garment system, as claimed in claims 1, 10 (depending from 1), 12, are each patentably distinguishable from the structure and interconnection of Clement. The therapeutic garment system of claim 1 and 10 recites, as amended herein: elasticized wrap-around first and second unitary style garments for donning and releasably securing in a close-fitting fashion at generally different areas of the body; each of said unitary style garments comprising an outwardly facing surface at least a portion of which is adapted for accepting an area of releasable fasteners, and an under-layer having an inwardly facing surface to resist slippage when donned. The garment system of claim 12 recites, as amended herein: elasticized wrap-around first and second unitary style garments for donning and releasably securing in a close-fitting fashion at generally different areas of the body; each of said unitary style garments comprising an outwardly facing surface adapted for accepting an area of releasable fasteners, ...

Support for applicant's unitary style garment embodiment is found throughout the specification, including pp. 5, 7, 10 – 11, and throughout applicant's figures. By way of comparison, for handy reference, herein, FIG. 1 of Clement has been reproduced, depicting its two-piece shoulder saddle 11 design made up of thin metal (stiff) strip 20 and a cloth, textile tape, or polymeric strap 16. One would be led away from designing elasticized first and second unitary style garments when introduced with the stiff, two-piece design of Clement's shoulder saddle. Clement's shoulder saddle operates to anchor the shoulder "in a manner similar to the deltoids to maintain the integrity of the shoulder [col. 1, lines 47 – 48]."



**Rejections under 35 USC §102 |Anticipation & §103 |Obviousness – Legal Summary**

As we know: "For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference . . . These elements must be arranged as in the claim under review . . .," *In re Bond* (Fed. Cir. 1990). The Federal Circuit has reiterated that "[t]here must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention, [*Scripps Clinic & Research Foundation*]". A prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, every limitation of the claim. See *Verdegaal Bros., Inc. v. Union Oil Co.* (Fed. Cir. 1987). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.* (Fed. Cir. 1986). An anticipation rejection under §102 can stand against a pending claim *only* if a single piece of prior art discloses a combination including *each* element of the pending claim such that each prior art element is identical to a corresponding, similar structurally-arranged and operationally substantial equivalent element of the pending claim. This is not the case, here. For reasons enumerated, each claim includes features not disclosed in any reference cited.

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The Supreme Court continued "[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement." *Id.* The Court explained, "[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *Id.* at 1740-41, 82 USPQ2d at 1396. The Court noted that "[t]o facilitate review, this analysis should be made explicit." *Id.*, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

Further, while precedent from the federal courts has shifted somewhat, in certain aspects, toward providing greater flexibility to examiners in rejecting claims during examination, it is still

U.S. Appl. No. 10/526,320 | response to Final action posted: 06-Jan 2010  
Amendment under 27 CFR 1.116 (filed within 2 mos. of posting Final action): Monday, 08-Mar 2010

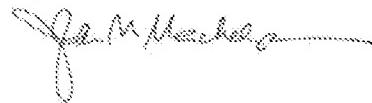
impermissible to apply hindsight in combining references or when using artisan general technical knowledge to draw conclusions in support of rejections.

Here, it is *not* a case of a substitution of one element—for instance, a mechanical actuator device replaced by a processor-driven device to perform the same function—as was the case set out by the Federal Circuit where it concluded, upon application of *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007) that it would have been obvious to combine (1) a mechanical device for actuating a phonograph to play back sounds associated with a letter in a word on a puzzle piece with (2) an electronic, processor-driven device capable of playing the sound associated with a first letter of a word in a book. See *Leapfrog Ent., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161, 82 USPQ2d 1687, 1690-91 (Fed. Cir. 2007) (“[a]ccommodating a prior art mechanical device that accomplishes [a desired] goal to modern electronics would have been reasonably obvious to one of ordinary skill in designing children's learning devices”). And, while *KSR* may foreclose (during prosecution of a patent application) narrow, open-and-shut arguments from an applicant that are based solely on the absence of specific expressed (or, written) teaching or suggestion in the cited references to produce the claimed combination—that is not the case where an inventor – such as the applicant – is faced with complex and unordinary design issues.

#### Summary and Request for Reconsideration

The garment system claimed in claims 1, 10, 12 (reciting first and second unitary style garments) is structurally different and unobvious from that disclosed or contemplated by Clement. Claims 2-3, 5-9, 11, 14, 20, 22-28 stand *objected to* for being dependent upon a rejected base claim; each of these claims has been amended in a manner consistent with suggestions made by the examiner. As such, each of applicant's pending claims stand patentable. Clement stops short of the innovation claimed in applicants' independent claims. And, although each dependent claim depending from an independent claim containing patentable subject matter is also considered patentably distinct by way of inclusion of features of a respective patentable independent claim, applicant's dependent claims include further unique limitations. Favorable reconsideration is, once again, respectfully solicited.

Respectfully submitted this 8<sup>th</sup> day of March 2010



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